

08/533115



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/533,115	09/25/95	HUTTON	649-2

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LM21/0414

EXAMINER
RINEHART, M

ART UNIT	PAPER NUMBER
2756	


DATE MAILED:

04/14/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

See Attachment.


**MARK H. RINEHART
PRIMARY EXAMINER**

Office Action Summary

Application No.
08/533,115

Applicant(s)
Hutton et al.

Examiner
Mark H. Rinehart

Group Art Unit
2756



☒ Responsive to communication(s) filed on 12/4/97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-68 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-68 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892.

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2,4,5,13

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2756

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 6-11, 21, 26-64, and 66-67, drawn to a system, apparatus, and method for querying a database server from a first computer to determine the status and identifier associated with a second computer within the operating network for establishing a connection, classified in class 395, subclass 200.58.
 - II. Claims 12-16, 19-20, 22-25, and 68, drawn to a system, apparatus, and method for directing an electronic mail message from a first computer through a network to a second computer for initiating the second computer to directly message the first computer with its address, classified in class 395, subclass 200.37.
 - III. Claims 17-18, drawn to an apparatus for initiating an electronic mail transmission, classified in class 395, subclass 300.36.
 - IV. Claim 65, drawn to a method for updating and querying a status database server, classified in class 395, subclass 200.54.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as allowing a communicating computer to establish the identifier and online status of a second computer with identifying itself to the second computer to accomodate privacy concerns; invention II has

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separate utility such as allowing a called computer to determine the sender of a connection request and directly respond or refuse a connection with the calling computer; invention III has separate utility such as preparing a mail message for electronic transmission to a distribution mail server; and invention IV has separate utility such as monitoring status of computers on a network system to enable management of a network system. See MPEP § 806.05(d).

3. Claim 5 link(s) inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 5. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and the search required for each of Groups I-IV is not required for each of the other Groups, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. A telephone call was made to Bruce D. Jobse, Reg. # 33,518, on 4/10/98 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. The Examiner notes that the disclosed inventions are rather complex in some of the details of the embodiments disclosed and claimed. While an election is required at this time, the Examiner would be willing to consider restriction of the invention based upon different groupings

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should the Applicant wish to propose a different grouping of the claims for examination. An interview to such effect would be entertained by the Examiner if it would aid in establishing a more acceptable grouping of the claims for examination in order to advance prosecution of the application.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Rinehart whose telephone number is (703) 305-4815. The examiner can normally be reached on Monday through Thursday from 8:00 AM - 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Supervisory Primary Examiner Frank J. Asta, can be reached on (703) 305-3817. The fax phone number for the Electrical Examining Technology Center is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mark H. Rinehart
Primary Examiner
Art Unit 2756




MARK H. RINEHART
PRIMARY EXAMINER